

Remarks

Claims 1-64 are pending, with claims 14, 16-18, 39, 43-45 and 57-60 being withdrawn by the Office Action as directed to a non-elected species. The remaining claims stand rejected under various prior art rejections.

There are two form rejections in the Office Action that have been addressed by amendment above. Specifically, the specification has been amended as suggested by the examiner, and claims 5, 26 and 49 have been amended.

There are numerous prior art rejections.

Claims 1-13, 15, 19-22 are allowable.

Claim 1 has been rejected under three different anticipation rejections, based on Wolf *et al.*, Lambert, and Forehand, respectively. The Applicants respectfully traverse.

Claim 1 recites a door-latching system having a latch assembly “moveable from a maintained release position to a door-blocking position.” The latch assembly is able to “remain in the maintained release position to allow at least some of the plurality of door panels to travel past the latch assembly.” By amendment, claim 1 further recites a traveling member mountable to the plurality of door panels, “wherein the traveling member engaging the latch assembly moves the latch assembly from the maintained release position to the door-blocking position.” None of the prior art teaches the recited latch assembly.

The first two patents in the anticipation rejections of claim 1, i.e., Wolf *et al.* and Lambert, are quite different from the claimed subject matter. Both patents describe older door systems, which are plagued by the clacking and snapping-movement effects described in the present application. In the description of related art section of the present application, for example, the snapping movement is described in detail. Doors such as those of Wolf *et al.* and Lambert, i.e., doors that must engage and knock-out a releasing device as the door is raised, create undesirable wear on door parts, as well as a noise hazard. On page 6, line 11 *et seq.*, the present application describes an example structure that prevents such snapping or clacking in the form of a latch assembly that preferably has a release position that is a maintained release position. Neither Wolf *et al.* nor Lambert teach a latch assembly having a maintained release position.

The pertinent description of Wolf *et al.* is provided at Column 3, line 38 *et seq.* The apparatus of Wolf *et al.* has a strike pin 126 positioned such that, as the door is raised, the pin 126 ratchets up one or more teeth of a latch bar 88. The pin must engage the bar and knock it out of the way otherwise the Wolf *et al.* device does not block downward movement of the door. Thus, the bar has no maintained release position. The bar is biased by gravity to its blocking position at all times. The deficiencies of Wolf *et al.* are further demonstrated by the fact that there is no traveling member. Contrary to the Office Action's suggestion, the pin does not engage the latch assembly to move "the latch assembly from the maintained release position to the door-blocking position."

In short, Wolf *et al.* does not anticipate claim 1, or any of the claims depending therefrom.

The pertinent description of Lambert is provided at Column 3, line 29 *et seq.* There it is described that Lambert's release member 84 is normally in the restraining position, with its curved surface 94 facing downward. The release member must be in this position, because Lambert, like Wolf *et al.*, relies upon its door to physically knock the releasing member out of the way as the door opens. That is, the release member 84 is biased to its blocking position at all times. Clearly, Lambert does not teach or suggest a latch assembly that has a maintained release position or a traveling member that when "engaging the latch assembly moves the latch assembly from the maintained release position to the door-blocking position."

From the foregoing, it is clear that neither Wolf *et al.* nor Lambert teach the recited latch assembly and traveling member. The question now becomes: does Forehand?

Forehand does describe a locking device for a door. The apparatus includes a pin 61 that is horizontally movable to lock the door in place and prevent movement. Forehand, however, is primarily concerned with securing "the garage door against unauthorized entry," i.e., with securing a closed door against movement. Col. 3, ll.63-64. In fact, as described, the Forehand locking device is electrically controlled so as to cause the pin to be withdrawn "as soon as the door opener motor causes the door 11 to begin to move."

This difference is telling with respect to the Office Action's rejections of other claims. For example, the trip arm 95 of Forehand is referenced as a traveling member in a

rejection of a similar traveling member recitation in claim 23. Of course, the arm is at the upper end of the Forehand door and only activates a switch 87 when the door is the closed position. As the door moves from the closed position to the open position, the arm releases from the switch, the pin is retracted, and the door is free to move within its track. The only activation of the pin as the door is moving from a closed position to an open position would occur when the arm activates switch 85. Switch 85, however, is not part of the latch assembly identified by the Office Action (tabling the question of whether Forehand even teaches such a latch assembly). The Office Action identifies the apparatus 23 as the latch assembly, not the switch 85.

In sum, as with the other art of record, Forehand does not teach or suggest a traveling member that is able to engage the latch assembly as the plurality of door panels move from the closed position to the open position and “wherein the traveling member engaging the latch assembly moves the latch assembly from the maintained release position to the door-blocking position.” (emphasis added).

The only remaining rejection of claims 1-13, 15, 19-22 was that of claim 21, which stands rejected as obvious over Wolf *et al.* in combination with Schultz. It has been pointed out above that Wolf *et al.* do not teach the claimed subject matter, including the latch assembly and the traveling member. Schultz does not teach this subject matter either, and the Office Action does not even suggest as much.

As none of the prior art teaches or suggests the subject matter of claims 1-13, 15, 19-22, these claims are in condition for allowance. The rejections of these claims are traversed and reconsideration respectfully requested.

Claims 23-34 are allowable.

Claim 23 recites a door-latching system having “a traveling member mountable to the plurality of door panels such that the traveling member is able to engage the latch assembly as the plurality of door panels move from the closed position to the open position, wherein the traveling member engaging the latch assembly moves the latch assembly from the maintained release position to the door-blocking position.” The recited traveling member is similar to that of claim 1 and, thus, the rejections of these claims are traversed for reasons outlined above. Reconsideration is respectfully requested.

Claims 38, 40-42 and 46-55 are allowable.

Claim 38 has been amended to recite a traveling member similar to that of claim 1. As such, the rejections of claims 38-55 are traversed as outlined above.

Reconsideration is respectfully requested.

Method claims 35-37 are allowable.

Claims 35-37 stand rejected under a four-way obviousness rejection. The Applicant respectfully traverses.

First, no *prima facie* showing of obviousness has been made. Regarding the question of obviousness, the Office Action merely states that since “the references taken as a whole necessitate the steps described in said method, it would have been obvious...to carry out the necessary steps described by said method.” This statement appears to be little more than the circular reasoning emblematic of impermissible hindsight. The Office Action points to no teaching, suggestion or motivation in the prior art to make the purported four-way combination. Yet, that is essential to *prima facie* obviousness.

To establish a *prima facie* case, there must be some teaching, suggest, or motivation from the prior art to make the proposed combination or modification. One cannot rely upon the mere fact that references can be combined or modified, unless the prior art also suggests the desired combination. MPEP §2143.01 citing *In re Mills*, 916 F.2d 860 (Fed. Cir. 1992). Nor may one maintain a rejection based on the notion that the claimed subject matter was within the capabilities of one of ordinary skill in the art. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993) (stating that a rejection that the claimed inventions would have been well within the ordinary skill of the art at the time the invention was made is not sufficient to establish a *prima facie* case of obviousness). As explained by the Federal Circuit in *In re Rouffet*:

As this court has stated, “virtually all [inventions] are combinations of old elements.” Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue...To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the

same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In re Rouffet, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (citations omitted and emphasis added). As further explained in the In re Rouffet decision:

This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. In re Rouffet at 1458.

The Office Action points to no such motivation or suggestion and, therefore, is legally flawed and improper.

The obviousness rejection is also traversed as none of the cited references teach “moving the latch assembly to its door-blocking position in response to a traveling member engaging the latch assembly as the plurality of door panels move from the closed position to the open position,” as recited in claim 35. As no individual patent teaches the recitation, *a fortiori*, the combination of the four references cannot teach the claimed subject matter.

Reconsideration is requested.

Claims 56 and 61-64 are allowable.

Claims 56 and 61-41 stand rejected under the same obviousness rejection against claim 35 and its dependent claims. Again, as the Office Action points to no motivation or suggestion to make the purported four-way combination, the obviousness rejection is legally flawed and improper. Reconsideration is requested.

Additionally, the rejection may not be sustained even with a suggestion or motivation (if one existed), as none of the art of record teaches “sensing that the plurality of door panels have reached the open position in response to a traveling member engaging the latch assembly as the plurality of door panels move from the closed position to the open position,” as recited in claim 56. Reconsideration is requested based on this ground as well.

Conclusion

In view of the above, each of the presently pending claims in this application (1-13, 15, 19-38, 40-42, 46-56 and 61-64) is believed to be in immediate condition for

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allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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